

Docket No. 219922US0CONT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Takashi OKAZOE, et al.

SERIAL NO: 10/084,506

GAU: 1621

FILED: February 28, 2002

EXAMINER: Rosalynd Keys

FOR: PROCESS FOR PRODUCING A VICDICHLOORO ACID FLUORIDE

RECEIVED  
JAN 30 2004  
TECH CENTER 1600/2900

**INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97**

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant(s) wish to disclose the following information.

**REFERENCES**

- ☒ The applicant(s) wish to make of record the attached Chinese Office Action; bearing a Mailing Date: November 14, 2003 re: Application No.: 00811990.2.
- ☒ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

**RELATED CASES**

- ☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

**CERTIFICATION**

- ☒ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

**DEPOSIT ACCOUNT**

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 05/03)

Thomas M. Cunningham

Registration No. 45,394

**THE PATENT OFFICE OF THE STATE INTELLECTUAL PROPERTY OFFICE  
OF THE PEOPLE'S REPUBLIC OF CHINA**

Address: No. 6 Xi Tucheng Lu, Jimeng Qiao Haidian District, Beijing    Post code: 100088    P.O. BOX: Beijing 8020

**Shanghai Patent & Trademark Law Office**

Date of Dispatch  
November 14, 2003

Application No.: 00811990.2	Applicant: ASAHI GLASS COMPANY LTD.
Application Date: August 30, 2000	Agent:
Title: PROCESS FOR PRODUCING A VIC-DICHLORD ACID FLUORIDE	

**THE FIRST OFFICE ACTION  
(PCT APPLICATION IN THE NATIONAL PHASE)**

1. ☒ According to the Request for Substantive Examination raised by the applicant and based on the provision of Item 1, Article 35 of the Patent Law, the Examiner has proceeded with the Examination as to Substance on the above mentioned application for patent for invention.  
☐ According to Item 2, Article 35 of the Chinese Patent Law, the Patent Office has decided to examine the above application for patent for invention.
2. ☒ The applicant has requested that the filling date of  
    1999.08.31 at the JP Patent Office as the priority date,  
    2000.07.12 at the JP Patent Office as the priority date,  
    \_\_\_\_\_ at the \_\_\_\_\_ Patent Office as the priority date,
3. ☐ The following amended documents submitted by the applicant cannot be accepted for not conforming to the provision of Article 33 of the Patent Law:  
    ☐ The Chinese version of the attachment of the International Preliminary Examination Report.  
    ☐ The Chinese version of the amended document submitted according to the provision of Rule 19 of the Patent Cooperation Treaty.  
    ☐ The amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.  
    ☐ The amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.  
    Refer to the text of the notice for the specific reason of non-acceptance thereof.
4. ☒ The examination is conducted by directing at the Chinese version of the original International Application submitted.  
    ☐ The examination is conducted by directing at the following application documents:  
        ☐ Description,  
            p. \_\_\_\_\_, the Chinese version of the original International Application Document submitted;  
            p. \_\_\_\_\_, the Chinese version of the attachment of the International Preliminary Examination Report;  
            p. \_\_\_\_\_, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.

- p. \_\_\_\_\_, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

☐ **Claims,**

- \_\_\_\_\_, the Chinese version of the original International Application Document submitted.  
\_\_\_\_\_, the Chinese version of the amended document submitted according to the provision of Rule 19 of the Patent Cooperation Treaty.  
\_\_\_\_\_, the Chinese version of the attachment of the International Preliminary Report.  
\_\_\_\_\_, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.  
\_\_\_\_\_, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

☐ **Attached Drawings,**

- p. \_\_\_\_\_, the Chinese version of the original International Application Document submitted.  
p. \_\_\_\_\_, the Chinese version of the attachment of the International Preliminary Examination Report.  
p. \_\_\_\_\_, the amended document submitted according to the provision of Rule 28 or Rule 41 of the Patent Cooperation Treaty.  
p. \_\_\_\_\_, the amended document submitted according to the provision of Rule 51 of the Implementing Regulations of the Patent Law.

5. ☒ This Notice cites the following Comparison Document(the number of which shall continue to be used in the subsequent examination proceedings):

No.	Number/Title of Document	Date of Publication (or the filing date of the conflicting Application)
1	JP2311438A	1990.12.27
2		
3		
4		

6. The conclusive opinion drawn from the examination:

☒ **As regards the Specification:**

- ☐ The contents of the application fall under the scope stipulated by Article 5 of the Patent Law for which no patent right should be granted.  
☒ The specification does not conform with the provision of Item 3, Article 26 of the Patent Law.  
☐ The drafting of the specification does not conform with the provision of Rule 18 of the Implementing Regulations.

☒ **As regards the Claims:**

- ☒ Claim 11 does not possess the novelty as stipulated in Item 2, Article 22 of the Patent Law.  
☒ Claim 11 does not possess the inventiveness as stipulated in Item 3, Article 22 of the Patent Law.  
☐ Claim \_\_\_\_\_ does not possess the practical applicability as stipulated in Item 4, Article 22 of the Patent Law.  
☐ Claim \_\_\_\_\_ falls under the scope of Article 25 of the Patent Law where no patent right is to be granted.  
☒ Claim 2.11 does not conform with the provision of Item 4, Article 26 of the Patent Law.

- ☐ Claim \_\_\_\_\_ does not conform with the provision of Item 1, Article 31 of the Patent Law.
- ☐ Claim \_\_\_\_\_ does not conform with the provision of Item 1, Rule 13 of the Implementing Regulations of the Patent Law.
- ☐ Claim \_\_\_\_\_ does not conform with the provision of Rule 18 of the Implementing Regulations of the Patent Law.
- ☒ Claim 1.5.6 does not conform with the provisions of Rules 20 to 23 of the Implementing Regulations of the Patent Law.

Refer to the text of this Notice for the specific analyses of the conclusive opinion.

7. Based on the above conclusive opinion, the Examiner deems that:

- ☐ The applicant shall amend the application documents in accordance with the requirements raised in the text of the Notice.
- ☒ The applicant shall discuss in his observations reasons why this application for patent can be granted a patent right, and amend the portions indicated in the text of the Notice which have been deemed as not conforming with the provisions, or no patent right shall be granted.
- ☐ There are no substantive contents in the application for patent that can be granted a patent right. If the applicant does not present reasons or the reasons presented are not sufficient, the application shall be rejected.

8. The applicant is asked to note the following items:

- (1) According to the provision of Article 37 of the Patent Law, the applicant shall submit his observations within four months from the receipt of this Notice. Where, without justified reasons, the applicant does not respond at the expiration of said date, the application shall be deemed to have been withdrawn.
- (2) The applicant shall amend his application according to Article 33 of the Patent Law. The amended documents shall be in duplicate, and the form, in conformity with the relevant provisions in the Examination Guide.
- (3) The applicant and/or his agent can not, without first making an appointment, go to the Patent Office to have an interview with the Examiner.
- (4) The observations and/or the amended documents shall be mailed or delivered to the Department of Receipt, the Patent Office of the State Intellectual Property Office. No documents shall possess legal effects if not mailed or delivered to the Department of Receipt.

9. The text of this Notice totals 1 page(s), and includes the following attachment(s):

- ☒ duplicate copy(ies) of cited comparison document(s), altogether 1 copy(ies) 1 pages.
- ☐

Examination Department: \_\_\_\_\_ Examiner(Seal):

## The Text of the First Office Action

The present invention relates to a process for producing a vic-dichloro acid fluoride. After examination, the Examiner provides the following opinions.

1. Claim 11 does not have novelty under Item 2, Article 22 of the Patent Law. Claim 11 asks to protect 11 compounds. However, Comparison Document 1 (D1, JP 2311438) has disclosed compound  $\text{CF}_2\text{CFYO}(\text{CF}_2)_4\text{COZ}$ , wherein X and Y are Cl, Br or I, Z is F (See Abstract of D1). Therefore, Claim 11 does not have novelty.

Even if the applicant deletes the compounds which do not have novelty, the structures of the remaining compounds are similar to those of D1, and they have the same uses and effects. Therefore, the remaining compounds do not have predominant substantial features nor represent a notable progress. They do not have inventiveness. Therefore, Claim 11 does not have the prospect of being patented.

There are no specific preparation Examples and chemical and physical data to support Compounds 4, 7 and 8 (numbered subsequently). Therefore, these compounds do not accord with Item 3, Article 26 of the Patent Law.

Further, the applicant should also amend the application documents as follows:

2. Omitted.

3. In line 19 on page 3 of the Chinese text, the "corresponding to" in the sentence "when no hydrogen atom is present in  $\text{R}^{\text{H}2}$ ,  $\text{R}^{\text{H}3}$  or  $\text{R}^{\text{HB}}$ ,  $\text{R}^{\text{F}2}$ ,  $\text{R}^{\text{F}3}$  or  $\text{R}^{\text{FB}}$  is a group corresponding to  $\text{R}^{\text{H}2}$ ,  $\text{R}^{\text{H}3}$  or  $\text{R}^{\text{HB}}$  respectively" should be "identical to", thus making the specification in accord with Item 3, Article 26 of the Patent Law. At the same time, the corresponding contents in Claim 1 should be amended to make it conform to Item 1, Rule 20 of the Implementing Regulations.

4. The feature of "a molecular weight of the compound (I) is from 200-1000" in Claim 2 does not accord with the descriptions in the specification. Therefore, Claim 2 does not accord with Item 4, Article 26 of the Patent Law.

5. Claim 5 and Claim 6 lack the definitions for  $\text{R}^{\text{HB}}$  and  $\text{E}^{\text{H}1}$ , respectively, resulting in the protection scopes unclear, thus not in accord with Item 1, Rule 20 of the Patent Law. The applicant should define  $\text{R}^{\text{HB}}$  and  $\text{E}^{\text{H}1}$  according to the way of defining the other groups, such as  $\text{R}^{\text{H}1}$  and  $\text{E}^{\text{H}1}$ , etc. And, at the same time, the applicant should note that such expression should have been disclosed in the original text.

6. The brackets and the contents thereof lead to the protection scope of Claim 1 unclear, thus not in accord with Item 1, Rule 20 of the Patent Law.

The applicant should respond to the Office Action within the time limit, and answer the above questions one by one. When necessary, he should amend the application documents. Otherwise, the present application will be difficult to be patented. The applicant should note that the amendments should accord with Article 33 of the Patent Law, i.e., the amendments should not go beyond the disclosure of the original specification and claims.